

REMARKS

This reply is submitted in response to the Office action dated September 24, 2009.

Claims 1- 48 are before the Examiner. Claims 1, 3, 11, 12, 26-29, 40, and 41 have been amended. Support is found in the claims as originally filed. Claims 9, 10, 15, 32 and 34 have been cancelled. No new matter has been added.

Please reconsider the application in light of the above amendments and following remarks.

Restriction Requirement

Claims 1-48 were subjected to a six way restriction requirement. Applicant respectfully disagreed with restriction requirement, however, elected the claims of Group I, claims 1-9, 13-39, 42-48 drawn to a process of preparing epoxides, with traverse.

Applicant has removed the non-elected groups from all independent claims.

Claims 11, 12, 40 and 41 are withdrawn as drawn to non-elected groups. Applicant respectfully disagrees and requests rejoinder of claims 11, 12, 40 and 41 under MPEP § 821.04(a).

Specifically MPEP § 821.04(a) states: "Where restriction was required ...between independent or distinct processes, and all claims directed to an elected invention are allowable, **any restriction requirement between the elected invention and any nonelected invention that depends from or otherwise requires all the limitations of an allowable claim should be withdrawn...** Claims that require all the limitations of an allowable claim will be rejoined and fully examined for patentability in accordance with 37 CFR § 1.104...." (Emphasis added)

Claims 11 and 12 depend from, or otherwise require, all the limitations of allowable claim 1 and claims 40 and 41 depend from, or otherwise require, all the limitations of allowable claim 26. Thus, under MPEP § 821.04(a), the restriction requirement must be withdrawn and claims 11, 12, 40 and 41 must be examined in accordance with 37 CFR § 1.104.

Since claims 11, 12, 40 and 41 require all the limitations of an allowable claim, Applicant respectfully submits that claims 12, 12 40 and 40 are also thus allowable.

In the response to arguments (page 3-4 of the Office action), the Examiner suggests that claims 11, 12, 40 and 41 should not be rejoined because they produce "different" products from the Group I epoxide. Applicant respectfully disagrees and submits that this statement is in error. Claims 11, 12, 40 and 41 produce epoxide first then further obtain the acid or alcohol from that epoxide. Claims 11, 12, 40 and 41 do not so much as make a different product as they make a product from the epoxide. Thus, Applicant respectfully submits that claims 11, 12, 40 and 41 should be rejoined with Group I and allowance of claims 11, 12, 40 and 41 is respectfully requested.

Claim Objections

Claims 1-8, 13, 14 and 16-25 are objected to as containing non-elected subject matter. Applicant has removed the non-elected material from the independent claims.

Claim 29 is objected to as being dependent on a rejected base claim but would be allowable if re-written in independent form. Applicant has rewritten claim 29 in independent form.

Rejection under 35 USC § 112, second paragraph

Claims 3, 27 and 28 are rejected under 35 USC § 112, first paragraph for using group names in the Periodic Table of the Elements. Applicant respectfully disagrees; however to further the prosecution process has deleted the offending language and inserted a Markush group of metals or specific metals. This amendment is supported by page 7, lines 8-10 of the published application (WO 99/64376). Withdrawal of the rejection is requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and respectfully requests notice of such.

Please charge any deficiency in fees or credit any overpayments during the entire pendency of this case to Deposit Account No. 05-1712. Please also charge any petition fees,

including fees for extensions of time necessary for the pendency of this case or copendency of this application with another application at any time to Deposit Account No. 05-1712.

Respectfully submitted,

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